

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Takashi WATANABE et al.
Title: DIFFERENTIAL AND DIFFERENTIAL CASE
Appl. No.: 10/780,587
Filing Date: 02/19/2004
Patent No.: 7,445,088
Grant Date: 11/04/2008
Examiner: James PILKINGTON
Art Unit: 3682
Confirmation Number: 2484

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on November 4, 2008 as U.S. Patent No. 7,445,088.

The Patent Office determined that the patent was entitled to 453 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of

“overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court’s interpretation of the PTA statute, and have determined that the patent is entitled to 867 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 996 days

(b) Total Applicant delay: 129 days

Final PTA Determination: 867 days

Applicants therefore respectfully request that the patent be accorded 867 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date December 22, 2008

By 

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Patent Term Adjustment Calculation System

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Docket Number: 023971-0377

Application Number: 10/780587

Patent Number: 7445088

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	02/19/2004	0		
	14 month From Application date	04/19/2005	425		
Edit Delete	Restriction Requirement	11/22/2006	1,007	582	
	3 Year Period Starts	02/19/2007	1,096		
Edit Delete	Restriction Requirement Response Received at PTO	02/21/2007	1,098		
Edit Delete	Non-Final Office Action	04/12/2007	1,148		
	Non-Final Office Action + 3 months	07/12/2007	1,239		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	09/12/2007	1,301		62
Edit Delete	Final Office Action	11/08/2007	1,358		
	Final Office Action + 3 months	02/08/2008	1,450		
Edit Delete	Final Office Action Response Received at PTO	02/08/2008	1,450		
Edit Delete	Advisory Action	03/11/2008	1,482		
Edit Delete	Request For Continued Examination	04/08/2008	1,510		60
	3 Year Period Stopped	04/08/2008	1,510	414	
Edit Delete	Notice of Allowance	06/27/2008	1,590		
Edit Delete	Rule 312 Amendment Received at PTO	09/25/2008	1,680		
Edit Delete	Issue Fee Paid	09/25/2008	1,680		
Edit Delete	Response to Rule 312 Communication Received	10/01/2008	1,686		7
Edit Delete	Patent Grant Date	11/04/2008	1,720		
	Totals:			996	129
	PTA:			867	

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IP: 10.14.54.152

Foley & Lardner LLP